



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/802,401	03/17/2004	Achim Hartlaub	82448	3701

22242 7590 09/19/2006

FITCH EVEN TABIN AND FLANNERY  
120 SOUTH LA SALLE STREET  
SUITE 1600  
CHICAGO, IL 60603-3406

EXAMINER

LUONG, VINH

ART UNIT PAPER NUMBER

3682

DATE MAILED: 09/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/802,401

Applicant(s)

HARTLAUB ET AL.

Examiner

Vinh T. Luong

Art Unit

3682

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 7/19/06 & 8/29/06.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 2-20 is/are pending in the application.
- 4a) Of the above claim(s) 7 and 8 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2,3,5,6 and 9-20 is/are rejected.
- 7) ☒ Claim(s) 4 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 November 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

  
Vinh T. Luong  
Primary Examiner

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>8/29/06</u> . | 6) <input checked="" type="checkbox"/> Other: <u>Attachment</u> .                       |

Art Unit: 3682

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on July 19, 2006 has been entered.
2. Claims 7 and 8 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on April 8, 2005.
3. The drawings were received on November 25, 2005. These drawings are accepted by the Examiner.
4. Claim 14 is objected to because of the following informalities: no antecedent basis is seen for the term "the build-on *parts*" (plural, emphasis) in claim 14. Appropriate correction is required.
5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
6. Claims 2, 3, 5, 6, 9, 12, 13, and 15-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Miyako et al. (US Patent Publication 2002/0033321 A1 cited by Applicant from the Office action of Japanese Patent Office).

Regarding claim 16, Miyako teaches a steering wheel 1 for mounting of a build-on part 3 thereon, the steering wheel 1 comprising:

a steering wheel skeleton 11;

foam material 12 (Figs. 1 and 2), 22 (Figs. 3 and 4) surrounding the skeleton 11;

Art Unit: 3682

a holding part 4, 9 (Figs. 1 and 2), 21 (Figs. 3 and 4) that is fixed relative to the skeleton 11 by the foam material 22 so that a first portion 9, 9a (Fig. 1), and unnumbered (at 23 in Fig. 4. See Attachment) of the holding part 4, 9 (Fig. 1), 21 (Fig. 4) is fixed within the foam material 12, 22 against removal therefrom and a second portion 4 (Fig. 1), 21b (Fig. 4) of the holding part 21 projects therefrom for mounting of the build-on part 3 thereto. See Attachment and Miyako's claims 1-5.

Regarding claim 2, the holding part 3, 9 (Fig. 1), 21 (Fig. 4) bears against the steering wheel skeleton 11.

Regarding claim 3, it is well settled that the patentability of a product does not depend on its method of production, such as, adhesive bonding. *In re Thorpe*, 227 USPQ 964, 966 (CAFC 1985); *In re Brown*, 173 USPQ 685 (CCPA 1972); *In re Fessmann*, 180 USPQ 324 (CCPA 1974); *Ex parte Edwards*, 231 USPQ 981 (BPAI 1986); and MPEP 2113.

Regarding claim 5, the holding part 4, 9 (Fig. 1) surrounds the steering wheel skeleton 11 at least partially at one point (at 9 in Fig. 1).

Regarding claim 6, the portion 9 of the holding part 4, 9 has a U-shaped configuration (the base of the U-shape is positioned along the board 6 as seen in Fig. 1) adjacent the steering wheel skeleton 11.

Regarding claim 9, the holding part 4, 9 or 21 is adjacent a spoke 1c (Fig. 2) of the steering wheel 1.

Regarding claim 12, the build-on part 3 comprises an adaptor 6 (Fig. 1), which is connected to the holding part 4, 9 and allows an additional build-on part 5 to be connected thereto.

Art Unit: 3682

Regarding claim 13, the adaptor 6 is an adaptor plate 6.

Regarding claim 15, the first portion (unnumbered in Fig. 4. See Att.) of the holding part 21 which lies within the steering wheel foam surround 22 has a smaller longitudinal extent than the (second) portion 21b (Att.) which lies outside the steering wheel foam surround 22.

Regarding claim 17, the skeleton 11 is free of drilled openings for receiving fasteners for supporting the holding part 4, 9 in substantially fixed relation thereto. See paragraph [0031].

Regarding claim 18, the first portion (unnumbered at 23 in Fig. 4. See Att.) is spaced from the skeleton 11 and embedded in the foam material 22 to be surrounded thereby.

Regarding claim 19, the foam material 12 provides the only holding force between the holding part 9, 4 and the skeleton 11 as seen in Fig. 1.

Regarding claim 20, the skeleton 11 and the holding part 9, 4 (Fig. 1) or 21 (Fig. 4) inherently have predetermined substantially fixed positions relative to each other via molding of the foam material 12, 22 to surround the skeleton 11 with the skeleton 11 and the holding part 9, 4 or 21 in the predetermined substantially fixed positions as shown in Figs. 1-4.

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.

Art Unit: 3682

2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

9. Claims 10, 11, and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miyako et al.

Regarding claims 10 and 11, Miyako teaches the invention substantially as claimed. However, Miyako does not explicitly teach the metal or plastic holding part 9, 4 (Fig. 1) or 21 (Fig. 4).

Miyako teaches the well-known metal or plastic material (metal core 11 and plastic casing 4. See, e.g., paragraphs [0021] and [0022]) in order to reduce the cost of manufacturing. See *In re Leshin*, 227 F.2d 197, 125 USPQ 416 (CCPA 1960) and MPEP 2144.07.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to choose the well known metal or plastic material as the material for Miyako's holding part in order to reduce the cost of manufacturing as taught or suggest by Miyako.

Regarding claim 14, Miyako teaches the invention substantially as claimed. However, Miyako's holding part 9, 4 (Fig. 1) or 21 (Fig. 4) is not connected to the build-on part 3 by means of screws or rivets.

It is common knowledge in the art to use the screws or rivets in order to connect the holding part to the build-on part as evidenced by Miyako's description in paragraphs [0002] and [0003].

Art Unit: 3682

It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the screws or rivets in order to connect Miyako's holding part to the build-on part as taught or suggested by common knowledge in the art.

10. Claim 4 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

11. Applicant's arguments filed July 19, 2006 have been fully considered but they are not persuasive.

Applicant's arguments with respect to claims 1-6 and 9-20 have been considered but are moot in view of the new ground(s) of rejection.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vinh T. Luong whose telephone number is 571-272-7109. The examiner can normally be reached on Monday - Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Ridley can be reached on 571-272-6917. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Luong

September 14, 2006



Vinh T. Luong  
Primary Examiner

# **ATTACHMENT**



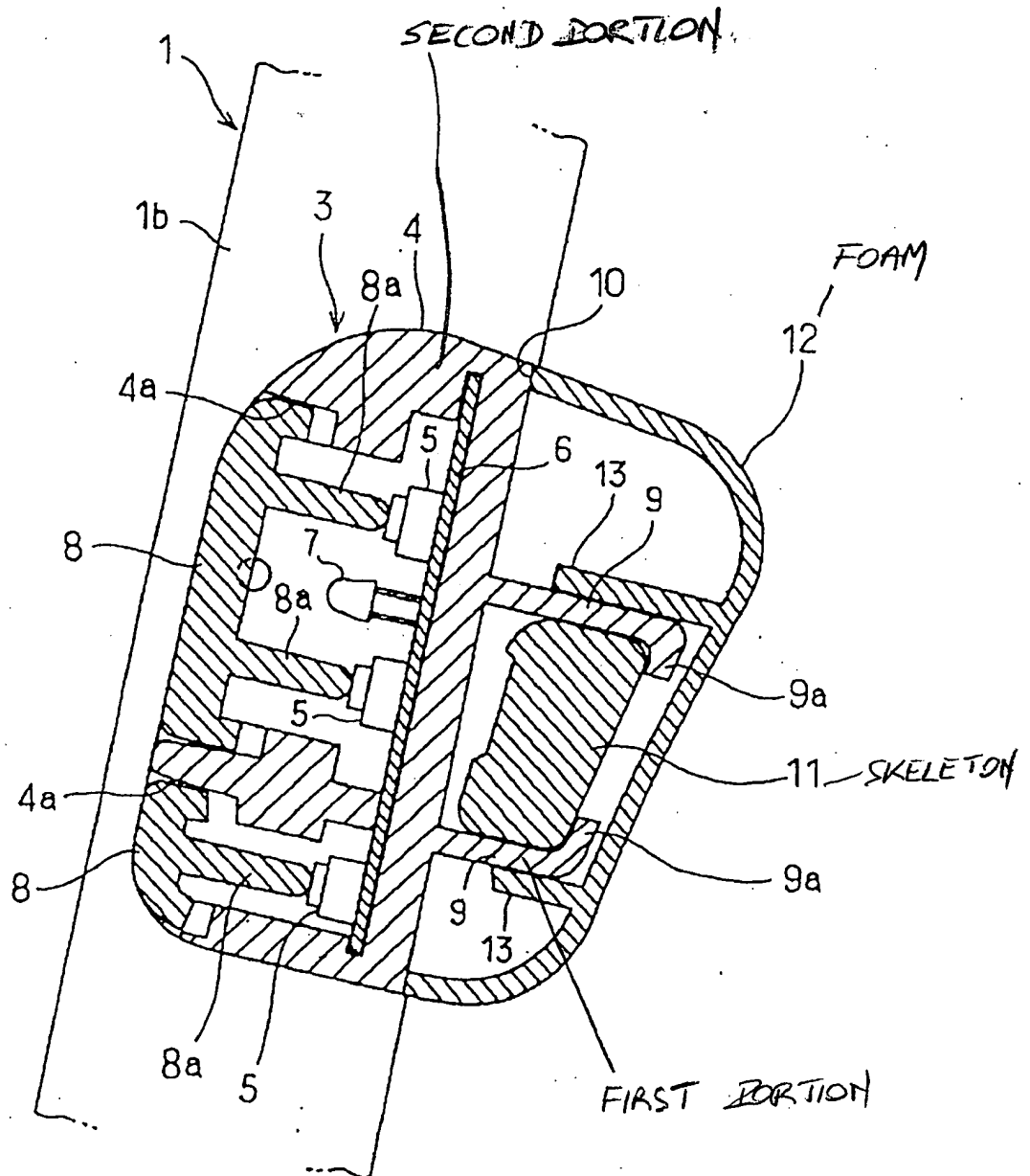


FIG. 1

PAGE 1 OF 3

FIG 3

